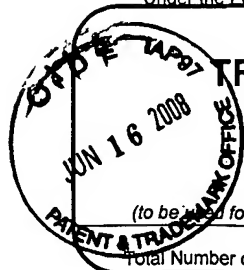


Under the Paperwork Reduction Act of 1995, no persons are required to respond to a collection of information unless it displays a valid OMB control number.

TRANSMITTAL  
FORM

(to be used for all correspondence after initial filing)

Total Number of Pages in This Submission

39

Application Number	10/734,671
Filing Date	12/12/2003
First Named Inventor	Foerster
Art Unit	3736
Examiner Name	Apanius
Attorney Docket Number	END-897DIV3

## ENCLOSURES (Check all that apply)

- |  |  |  |
|--|--|--|
| <input checked="" type="checkbox"/> Fee Transmittal Form<br><input checked="" type="checkbox"/> Fee Attached<br><input type="checkbox"/> Amendment/Reply<br><input type="checkbox"/> After Final<br><input type="checkbox"/> Affidavits/declaration(s)<br><input type="checkbox"/> Extension of Time Request<br><input type="checkbox"/> Express Abandonment Request<br><input type="checkbox"/> Information Disclosure Statement<br><br><input type="checkbox"/> Certified Copy of Priority Document(s)<br><input type="checkbox"/> Reply to Missing Parts/<br>Incomplete Application<br><input type="checkbox"/> Reply to Missing Parts<br>under 37 CFR 1.52 or 1.53 | <input type="checkbox"/> Drawing(s)<br><input type="checkbox"/> Licensing-related Papers<br><input type="checkbox"/> Petition<br><input type="checkbox"/> Petition to Convert to a<br>Provisional Application<br><input type="checkbox"/> Power of Attorney, Revocation<br>Change of Correspondence Address<br><input type="checkbox"/> Terminal Disclaimer<br><input type="checkbox"/> Request for Refund<br><input type="checkbox"/> CD, Number of CD(s) _____<br><input type="checkbox"/> Landscape Table on CD | <input type="checkbox"/> After Allowance Communication to TC<br><input type="checkbox"/> Appeal Communication to Board<br>of Appeals and Interferences<br><input checked="" type="checkbox"/> Appeal Communication to TC<br>(Appeal Notice, Brief, Reply Brief)<br><input type="checkbox"/> Proprietary Information<br><input type="checkbox"/> Status Letter<br><input type="checkbox"/> Other Enclosure(s) (please identify<br>below): |
|--|--|--|

Remarks

## SIGNATURE OF APPLICANT, ATTORNEY, OR AGENT

Firm Name  
Welsh & Flaxman LLC

Signature

Printed name  
Howard N. FlaxmanDate  
06/16/2008Reg. No.  
34,595

## CERTIFICATE OF TRANSMISSION/MAILING

I hereby certify that this correspondence is being facsimile transmitted to the USPTO or deposited with the United States Postal Service with sufficient postage as first class mail in an envelope addressed to: Commissioner for Patents, P.O. Box 1450, Alexandria, VA 22313-1450 on the date shown below:

Signature

Typed or printed name

Date

This collection of information is required by 37 CFR 1.5. The information is required to obtain or retain a benefit by the public which is to file (and by the USPTO to process) an application. Confidentiality is governed by 35 U.S.C. 122 and 37 CFR 1.11 and 1.14. This collection is estimated to 2 hours to complete, including gathering, preparing, and submitting the completed application form to the USPTO. Time will vary depending upon the individual case. Any comments on the amount of time you require to complete this form and/or suggestions for reducing this burden, should be sent to the Chief Information Officer, U.S. Patent and Trademark Office, U.S. Department of Commerce, P.O. Box 1450, Alexandria, VA 22313-1450. DO NOT SEND FEES OR COMPLETED FORMS TO THIS ADDRESS. SEND TO: Commissioner for Patents, P.O. Box 1450, Alexandria, VA 22313-1450.

If you need assistance in completing the form, call 1-800-PTO-9199 and select option 2.

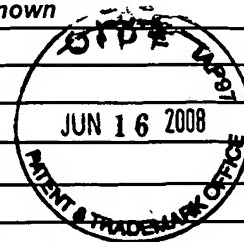
Under the Paperwork Reduction Act of 1995 no persons are required to respond to a collection of information unless it displays a valid OMB control number

Effective on 12/08/2004.

Fees pursuant to the Consolidated Appropriations Act, 2005 (H.R. 4818).

**FEE TRANSMITTAL**  
**For FY 2008****Complete if Known**

Application Number	10/734,671
Filing Date	12/12/2003
First Named Inventor	Foerster
Examiner Name	Apanius
Art Unit	3736
Attorney Docket No.	END-897DIV3

☐ Applicant claims small entity status. See 37 CFR 1.27

TOTAL AMOUNT OF PAYMENT (\$)

510.00

**METHOD OF PAYMENT (check all that apply)**☐ Check ☒ Credit Card ☐ Money Order ☐ None ☐ Other (please identify): \_\_\_\_\_☒ Deposit Account Deposit Account Number: 01-2221 Deposit Account Name: Welsh & Flaxman

For the above-identified deposit account, the Director is hereby authorized to: (check all that apply)

☐ Charge fee(s) indicated below ☐ Charge fee(s) indicated below, except for the filing fee☒ Charge any additional fee(s) or underpayments of fee(s) under 37 CFR 1.16 and 1.17 ☐ Credit any overpayments

WARNING: Information on this form may become public. Credit card information should not be included on this form. Provide credit card information and authorization on PTO-2038.

**FEE CALCULATION****1. BASIC FILING, SEARCH, AND EXAMINATION FEES**

Application Type	FILING FEES		SEARCH FEES		EXAMINATION FEES		Fees Paid (\$)
	Fee (\$)	Small Entity Fee (\$)	Fee (\$)	Small Entity Fee (\$)	Fee (\$)	Small Entity Fee (\$)	
Utility	310	155	510	255	210	105	
Design	210	105	100	50	130	65	
Plant	210	105	310	155	160	80	
Reissue	310	155	510	255	620	310	
Provisional	210	105	0	0	0	0	

**2. EXCESS CLAIM FEES****Fee Description**

Fee Description	Fee (\$)	Small Entity Fee (\$)
Each claim over 20 (including Reissues)	50	25
Each independent claim over 3 (including Reissues)	210	105
Multiple dependent claims	370	185

<b>Total Claims</b>	<b>Extra Claims</b>	<b>Fee (\$)</b>	<b>Fee Paid (\$)</b>
---------------------	---------------------	-----------------	----------------------

- 20 or HP = \_\_\_\_\_ x \_\_\_\_\_ = \_\_\_\_\_

HP = highest number of total claims paid for, if greater than 20.

<b>Indep. Claims</b>	<b>Extra Claims</b>	<b>Fee (\$)</b>	<b>Fee Paid (\$)</b>
----------------------	---------------------	-----------------	----------------------

- 3 or HP = \_\_\_\_\_ x \_\_\_\_\_ = \_\_\_\_\_

HP = highest number of independent claims paid for, if greater than 3.

**3. APPLICATION SIZE FEE**

If the specification and drawings exceed 100 sheets of paper (excluding electronically filed sequence or computer listings under 37 CFR 1.52(e)), the application size fee due is \$260 (\$130 for small entity) for each additional 50 sheets or fraction thereof. See 35 U.S.C. 41(a)(1)(G) and 37 CFR 1.16(s).

<b>Total Sheets</b>	<b>Extra Sheets</b>	<b>Number of each additional 50 or fraction thereof</b>	<b>Fee (\$)</b>	<b>Fee Paid (\$)</b>
---------------------	---------------------	---	-----------------	----------------------

- 100 = \_\_\_\_\_ / 50 = \_\_\_\_\_ (round up to a whole number) x \_\_\_\_\_ = \_\_\_\_\_

**4. OTHER FEE(S)**

Non-English Specification, \$130 fee (no small entity discount)

Other (e.g., late filing surcharge): Appeal Brief

510.00

**SUBMITTED BY**

Signature

Registration No. 34,595  
(Attorney/Agent)

Telephone 703 920 1122

Name (Print/Type) Howard N. Flaxman

Date 06/16/2008

This collection of information is required by 37 CFR 1.136. The information is required to obtain or retain a benefit by the public which is to file (and by the USPTO to process) an application. Confidentiality is governed by 35 U.S.C. 122 and 37 CFR 1.14. This collection is estimated to take 30 minutes to complete, including gathering, preparing, and submitting the completed application form to the USPTO. Time will vary depending upon the individual case. Any comments on the amount of time you require to complete this form and/or suggestions for reducing this burden, should be sent to the Chief Information Officer, U.S. Patent and Trademark Office, U.S. Department of Commerce, P.O. Box 1450, Alexandria, VA 22313-1450. DO NOT SEND FEES OR COMPLETED FORMS TO THIS ADDRESS. SEND TO: Commissioner for Patents, P.O. Box 1450, Alexandria, VA 22313-1450.

If you need assistance in completing the form, call 1-800-PTO-9199 and select option 2.



IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

Serial No. : 10/734,671  
Applicant : Foerster et al.  
Filed : 12/12/2003  
Group Art Unit: 3736  
Examiner : Apanius  
Docket No. : END-897DIV3  
Customer No.: 021884  
Title : METHODS AND DEVICES FOR DEFINING AND MARKING  
TISSUE

**APPEAL BRIEF**

Mail Stop Appeal Brief - Patents  
Commissioner of Patents and Trademarks  
PO Box 1450  
Alexandria, VA 22313-1450

Sir:

**REAL PARTY IN INTEREST**

Ethicon Endo-Surgery, Inc. is the real party in interest in the above referenced patent application.

06/17/2008 AWONDAF1 00000015 10734671  
01 FC:1402 510.00 OP

## **RELATED APPEALS AND INTERFERENCES**

Neither Appellants' representative, Appellants' assignee, nor Appellants are aware of any appeals and/or interferences effected by or having a bearing on the Board's decision in the pending appeal.

### **STATUS OF CLAIMS**

Claim 49 is currently pending and stand finally rejected. Claims 1-48 have been canceled.

Appellants accordingly appeal the Examiner's Final Rejection of claim 49.

## **STATUS OF AMENDMENTS**

No amendments have been filed subsequent to the Final Rejection. As to the amendments filed prior to the Final Rejection, all amendments appear to have been entered and considered.

## **SUMMARY OF THE CLAIMED SUBJECT MATTER**

Claim 49 is the only independent claim involved in the present Appeal. As such, claim 49 is summarized below. Claim 49 sets forth a delivery system (10) for delivering marker material (12) to a target site (51) within a patient. The delivery system (10) includes an elongate member (54) having a distal end, a discharge port in the distal end and an inner lumen (56) extending therein to and in fluid communication with the discharge port in the distal end. A mass of solid particulate marker material (one or more 12i) is disposed within the inner lumen (56). The delivery system (10) also includes an ejector (18, 24) which is advancable with and coupled to said elongate member (54) and which is configured to eject particulate marker material from the discharge port in said distal end of said elongate member (54). Support is found throughout the Specification as originally filed where the reference numerals listed above are used.

### **GROUND OF REJECTION TO BE REVIEWED ON APPEAL**

1. Whether claim 49 is unpatentable under 35 U.S.C. § 112, first paragraph, as failing to comply with the written description requirement.
2. Whether claim 49 is unpatentable under 35 U.S.C. § 103(a) over U.S. Patent No. 3,741,198 to Burton ("Burton") in view of U.S. Patent No. 5,123,414 to Unger ("Unger").



## ARGUMENTS

### I. CLAIM 49 IS IMPROPERLY REJECTED UNDER 35 U.S.C. § 112, 1st paragraph.

Claim 49 stands rejected under 35 U.S.C. § 112, first paragraph, as failing to comply with the written description requirement. The Specification as originally filed clearly discloses that the numerous different markers contemplated by the inventors are to be delivered via a tube 54 having a lumen 56, thus the written description inherently has to provide support for each and every marker 12a-j being “disposed within an inner lumen of the elongated member” as this is the only delivery means disclosed. Specifically, on numerous occasions in the Specification, the markers are disclosed as being preloaded, deployed or traveling through a lumen or tube. Page 7, lines 17-19, states, “[i]n some embodiments, these deployment functions are communicated by means of the marker elements themselves travelling through the lumen for deployment from the distal region”. Page 7, line 28, states, “...deployed from the lumen”. Page 8, line 4, states, “...deployment from the lumen...”. Page 15, lines 21-26, states, “[i]t is also within the scope of the invention to deliver the marker element through any tube which has access to the body or using optical medical instruments...through the body of the instrument”. Page 17, lines 9-11, states, “...a plurality of marker elements 12b (two are shown, though any number may be employed) may be preloaded into tube 54b...”.

Since the Examiner acknowledges that the disclosure supports a mass of solid particulate marker material, then it must also support delivering it via a tube and, in order to be delivered via the tube, the marker regardless of its form must at some point be disposed in the lumen in the tube.

One of ordinary skill in the art would surely be able to read the written description of the invention and then make and use what is claimed, which is all that 35 U.S.C. § 112, first paragraph requires. Therefore, the 112, 1<sup>st</sup> paragraph rejection is improper and should be reversed.

## **II. CLAIM 49 IS PATENTABLE OVER BURTON IN VIEW OF UNGER.**

Claim 49 stands rejected under 35 U.S.C. § 103(a) as being unpatentable over Burton in view of Unger. Appellants have claimed a delivery as described above in the “Summary” section.

Burton has been relied upon as teaching a syringe filled with a mass of solid particulate marker material disposed within an inner lumen. Although the Examiner asserts that “it is respectfully submitted that any material that can be detected in some manner can be considered a marker”, it is Appellants’ opinion Burton does not teach a marker material. A marker as claimed in accordance with the present invention has a specific purpose of marking a site and not traveling from that site. Contrary to what the Examiner believes, just because something is detectable does not in turn make it a marker.

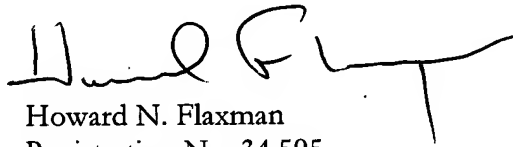
Appellant is delivering to a target site and not a moving site. If the marker were to move, it could no longer perform the function of marking the target site. Burton teaches a radiopaque contrast material in the form of a ferrofluid, which is a fluid containing magnetic particles for the purpose of moving the contrasting fluid up and down the spinal column. The ferrofluid may contain metallic particulate, but their purpose is not to mark. In fact, their purpose is to move the particles, and hence the fluid, along the spinal column during an examination. As such, Burton does not teach a marker and, in fact, teaches away from a marker. A marker as disclosed by Appellant is to mark a target site and Burton fails to teach marking a target site. With this in mind, Burton even if combined with Unger fails to teach the claimed invention.

Therefore, it is Appellants’ opinion the rejection of claim 49 is improper and respectfully request the outstanding rejection be reversed.

## II. CONCLUSION

In conclusion, Appellants have now shown that the §112 rejection is improper and the references cited by the Examiner neither disclose nor suggest the claimed invention. Therefore, it is respectfully requested that the outstanding rejections of claim 49 be reversed.

Respectfully submitted,

A handwritten signature in black ink, appearing to read 'Howard N. Flaxman', with a stylized flourish extending to the right.

Howard N. Flaxman  
Registration No. 34,595  
Attorney for Appellants

WELSH & FLAXMAN, LLC  
2000 Duke Street, Suite 100  
Alexandria, VA 22314  
(703) 920-1122

## CLAIMS APPENDIX

1-48. (Canceled)

49. A delivery system for delivering marker material to a target site within a patient, comprising:  
an elongate member having a distal end, a discharge port in the distal end and an inner lumen extending therein to and in fluid communication with the discharge port in the distal end;  
a mass of solid particulate marker material disposed within the inner lumen; and  
an ejector which is advancable with and coupled to said elongate member and which is configured to eject particulate marker material from the discharge port in said distal end of said elongate member.

## **EVIDENCE APPENDIX**

Not Applicable

**RELATED PROCEEDINGS APPENDIX**

Not Applicable